

REMARKS

Applicants wish to thank Examiner Edwards for indicating allowability of Claim 2, 3 and 4 if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1-12 are pending. Claims 6-10 have been withdrawn from consideration.

Applicants are filing herewith a Certified English translation of the Japanese priority document of the present application, JP 2003-063205, filed March 10, 2003, in order to perfect priority. This removes Inada et al, filed August 27, 2003, as a reference. Thus, the rejection of Claims 1 and 5 under 35 U.S.C. § 102(e) as anticipated by Inada et al (U.S. 6,783,852) should be withdrawn.

The rejection of Claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claim 1 of Inada et al (U.S. 6,783,852) is traversed.

The present invention as set forth in **Claim 1** relates to polyvinyl alcohol binder fibers having a cross-section circularity of at most 30 %, **a degree of swelling in water at 30°C of at least 100 %**, and a degree of dissolution in water of at most 20 %.

The claims of Inada et al fail to disclose or suggest polyvinyl alcohol binder fibers having **a degree of swelling in water at 30°C of at least 100 %**. Inada et al claim in Claim 1 a **water absorption ranging from 10 to 100 times the weight of the fibers**. However, degree of swelling is different from water absorption. The attached **Rule 132 Declaration** has a Figure which shows the difference between the degree of swelling and the water absorption. Notably, for a given value of water absorption, the degree of swelling is 100 times larger. In other words, the water absorption and the degree of swelling are defined as follows.

Water absorption= [(weight after absorbing water)-(weight after drying)/(weight after drying)](%).

Degree of swelling=[(weight after swelling)-(weight after drying)/(weight after drying)] X 100(%).

“Swelling” is used if the rate of water absorption is comparatively low. On the contrary, “water absorption” is used if “swelling” occurs in which a material absorbs water in an amount which is several times its weight.

Thus, this rejection should be withdrawn.

Further, Inada et al only exemplify fibers with a degree of dissolution (solubility) of 22.3 and 25.3%, which is higher than the claimed at most 20%.

Applicants affirm herewith the election, with traverse, of Group I, Claims 1-5 and a compound having an ethylene group as set forth in Claim 4.

With respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Non-elected claims 6-12 depend on elected Claim 1. Thus, if Claim 1 is allowable, Claims 6-12 should be allowable as well.

Applicants note that MPEP §821.04 states, "if applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims which depend from or otherwise include all the limitations of the allowable product claim will be rejoined." Applicants respectfully submit that should the elected group be found allowable, the non-elected method claims 11 and 12 should be rejoined.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the Restriction Requirement on the grounds that no adequate reasons and/or examples have been provided to support a conclusion of patentable distinctness between the identified groups or shown that a burden exists in searching all the claims.

The Office has characterized the inventions of Groups I-II as mutually exclusive species in an intermediate-final product relationship. Citing MPEP §806.04(b), third paragraph, the Office states that the intermediate product is useful as “a tow or a yarn”. The Office furthermore cites MPEP §806.04(h) in support of its assertion that the inventions are deemed patentably distinct on the ground that there is nothing on record to show them to be obvious variants. Applicants respectfully traverse the Restriction Requirement on the grounds that there is no evidence of record to conclude that the intermediate products are useful as the Office has suggested. Moreover, Applicants respectfully submit that the burden is on the Office to provide reasons to conclude that the inventions are patentably distinct, and is not on the Applicants to establish that they are not. Accordingly, the Restriction Requirement is believed to be improper, and it should be withdrawn.

In regard to Groups I and III, the Office has characterized the relationship between these two groups as “process of making and product made.” Citing MPEP §806.05(f), the Office suggests the product as claimed can be made by another and materially different process such as “adding, dissolving, spinning, coagulating, winding, drawing, drying, and flattening”. However, there is no evidence of record to show that the claimed products could be made as the Office has alleged. If, in fact, the claimed product can be made by a “adding, dissolving, spinning, coagulating, winding, drawing, drying, and flattening” process, the Office has failed to show that the alleged process of “adding, dissolving, spinning, coagulating, winding, drawing, drying, and flattening” is materially different from the

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claimed process. Accordingly, Applicants respectfully submit that the Restriction Requirement is unsustainable, and it should therefore be withdrawn.

Applicants respectfully traverse the Election of Species Requirement on the grounds that the Office has not provided any reasons, whatsoever, to support the conclusion of patentable distinctness. Rather, the Office has merely stated the conclusion.

Applicants make no statement regarding the patentable distinctness of the species, but note that for restriction to be proper, there must be a patentable difference between the species as claimed. MPEP §808.01(a). The Office has not provided any reasons or examples to support a conclusion that the species are indeed patentably distinct. Accordingly, Applicants respectfully submit that the restriction is improper, and Applicants' election of species is for examination purposes only.

Finally, with respect to the elected species, Applicants respectfully submit that, should the elected species be found allowable, the Office should expand its search to the non-elected species.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Restriction and Election of Species Requirement. Withdrawal of the Restriction and Election of Species Requirement is respectfully requested.

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This application presents allowable subject matter, and the Examiner is kindly requested to pass it to issue. Should the Examiner have any questions regarding the claims or otherwise wish to discuss this case, he is kindly invited to contact Applicants' below-signed representative, who would be happy to provide any assistance deemed necessary in speeding this application to allowance.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

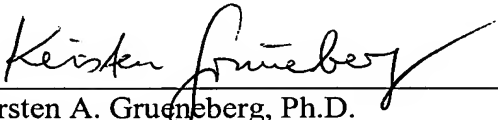
Customer Number

22850

Tel: (703) 413-3000

Fax: (703) 413 -2220

NFO:KAG:


Kirsten A. Grueneberg, Ph.D.
Registration No.: 47,297